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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/762,545 | 03/28/2001 | Ron H. Niswander | 43050 | 5242 |

7590

04/09/2004

John W. Jones
Locke Liddell & Sapp LLP
3400 Chase Tower
600 Travis Street
Houston, TX 77002-3095

EXAMINER

KUHNS, ALLAN R

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,545

Applicant(s)

NISWANDER

Examiner

KUHN S

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on MARCH 25, 2004
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

1. Upon further search and reconsideration, the finality of the Office action mailed December 29, 2003 is hereby withdrawn in order to introduce a new ground of rejection.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 5-6 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/25985 (Horn et al.) as set forth in the rejection of claims 1, 3 and 5-15 in the previous Office action.

4. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/25985 as applied to claims 1, 3, 5-6 and 10-15 above, and further in view of Clatty as set forth in the previous Office action.

5. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slocum et al. (5,019,317). Slocum et al. disclose or suggest the basic claimed composition and method of preparing a composition including reacting a fatty acid condensation product with an isocyanate in the presence of another compound (note the presence of the zinc carboxylate disclosed at column 2, line 21), wherein the fatty acid condensation product has at least one active hydrogen containing group. While Slocum et al. appear not to explicitly designate the zinc carboxylate as an IMR-enhancer compound, the existence of such an effect would have been obvious to one of ordinary skill in the art based on the disclosure in Slocum et al. in column 1. In addition,

note the brief description of the Slocum et al. reference provided by Jonsson et al. (5,529,739), now cited of interest, at column 1, lines 43-47.

6. Applicant's arguments filed March 25, 2004 have been fully considered but they are not persuasive. In responding to the arguments relating to WO 98/25985, the examiner is relying on Horn et al. (6,169,124) as a translation for the 25985 document. Applicant argues that Horn is deficient because it fails to disclose a fatty acid condensation product and that amine salts of fatty acids are not condensation products of fatty acids. This is confusing to the examiner because Applicant's specification at page 5, line 4 describes oleic acid as a most preferred fatty acid and then describes useful amines and amino alcohols for practicing the invention at page 5, lines 13-15.

Applicant also argues that Horn does not disclose the IMR enhancer but only discloses the IMR agent, and, in any event, does not disclose the mineral oil IMR enhancer recited in instant claim 5. This is not persuasive because Horn et al. disclose the use of mineral oils at column 9, line 15.

Applicant's arguments with regard to surface-active agents not being reactants, in conjunction with instant claims 7-9, are noted by the examiner. These arguments are considered to be moot by the examiner, based on the revised ground of rejection introduced in this Office action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (571) 272-1202. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Allan R. Kuhns
ALLAN R. KUHNS
PRIMARY EXAMINER AU 1732
4-5-04